

B. REMARKS

By this amendment, Claims 4 and 45 have been canceled. Hence, Claims 1, 3, 5-42, 44 and 46-84 are pending in this application. The amendments to the claims do not add any new matter to this application. All issues raised in the Office Action mailed October 18, 2005 are addressed hereinafter.

REJECTION OF CLAIMS 1, 3, 42, 44, 83 AND 84 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1, 3, 42, 44, 83 and 84 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The basis for the rejection with respect to Claims 1, 3, 42, 44 and 83 is that the limitation “transparently with respect to the application program” renders the claims indefinite “because it fails to clearly define the claimed limitation and fails to provide an intended teaching.” The basis for the rejection with respect to Claim 84 is that the terms “the elements” and “the data” lack antecedent basis.

With respect to Claims 1, 3, 42, 44 and 83, it is respectfully submitted that the limitation “transparently with respect to the application program” is clear on its face. The meaning of this limitation generally is that the item that was generated by the application program is modified without the involvement of the application program, or without the application program being aware that the modification was performed. With respect to Claim 21, this claim recites that the item is stored in a cache and that the intercepting step includes accessing the item stored in cache. It also recites that the step of sending the modified item to the client process includes replacing the item in the cache with the modified item. This claim does not further refine the modifying step recited in Claim 1, so it is not clear how this claim contributes to the confusion

over Claim 1. The Examiner is invited to contact the undersigned via telephone to discuss this matter if the Examiner believes that such contact would be helpful.

With respect to Claim 84, both “the elements” and “the data” are introduced in the first limitation beginning with “data indicating elements...” It is therefore respectfully submitted that no amendment is necessary to Claim 84 to correct any lack of antecedent basis issues.

In view of the foregoing, reconsideration and withdrawal of the rejection of Claims 1, 3, 42, 44, 83 and 84 under 35 U.S.C. § 112, second paragraph, is respectfully requested.

REJECTION OF CLAIMS 42, 44-82 AND 84 UNDER 35 U.S.C. § 101

Claims 42, 44-82 and 84 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is not moot with respect to canceled Claim 45. The basis for the rejection is that these claims are not limited to tangible embodiments since the specification describes that a computer-readable medium may include both tangible embodiments, such as a memory, and intangible embodiments, such as carrier waves. For purposes of expediting the prosecution of this application, these claims have been amended as indicated herein to recite computer-readable storage media to address the concerns raised in the Office Action. Accordingly, reconsideration and withdrawal of the rejection of Claims 42, 44, 46-82 and 84 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is respectfully requested.

Notwithstanding the foregoing, Applicant respectfully submits that Claims 42, 44, 46-82 and 84 were directed to statutory subject matter in the form as originally filed for at least two reasons. First, Applicant is not aware of any statutory, legal or other requirement that claims must be limited to tangible embodiments. Second, even if a tangibility requirement exists, it is respectfully submitted that Claims 42, 44, 46-82 and 84 are directed to tangible embodiments.

The text on Pages 51 and 52 of the specification of the present application describes that a computer-readable medium “refers to any medium that participates in providing instructions to processor 704 for execution. Such a medium may take many forms, including but not limited to, non-volatile media, volatile media, and transmission media.” With respect to transmission media, the specification describes that “[t]ransmission media includes coaxial cables, copper wire and fiber optics, including the wires that comprise bus 702. Transmission media can also take the form of acoustic or light waves, such as those generated during radio-wave and infra-red data communications. Common forms of computer-readable media include, for example, a floppy disk, a flexible disk, hard disk, magnetic tape, or any other magnetic medium, a CD-ROM, any other optical medium, punchcards, papertape, any other physical medium with patterns of holes, a RAM, a PROM, and EPROM, a FLASH-EPROM, any other memory chip or cartridge, a carrier wave as described hereinafter, or any other medium from which a computer can read.” It is respectfully submitted that a radio-wave, infra-red signal or carrier wave, from which a computer can read instructions, is just as tangible as a non-volatile or volatile media, such as hard disk or RAM, respectively.

REJECTION OF CLAIMS 1-5, 7, 8-20, 29, 42-46, 48-61, 70 AND 83 UNDER 35 U.S.C. § 103(a)

In the Office Action, Claims 1-5, 7, 8-20, 29, 42-46, 48-61, 70 and 83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess et al.*, U.S. Patent No. 5,696,701 (hereinafter “*Burgess*”) in view of *Grimm et al.*, U.S. Patent No. 6,317,868 (hereinafter “*Grimm*”). This rejection is now moot with respect to canceled Claims 4 and 45 (and previously canceled Claims 2 and 43). It is respectfully submitted that Claims 1, 3, 5, 7, 8-20, 29, 42, 44,

46, 48-61, 70 and 83, as amended, are patentable over *Burgess* and *Grimm* for at least the reasons provided hereinafter.

CLAIM 1

Claim 1, as amended, is directed to a method for measuring client side performance that recites:

“intercepting an item generated by an application program executing on a server device that is to be sent over a network to a client process executing on a client device, wherein the intercepting is performed prior to arrival of the item at the client process;
modifying the item transparently with respect to the application program to produce a modified item that includes code which, when processed by one or more processors at the client device causes:
at the client device, measuring performance related to a service associated with the item, and
at the client device, performing one or more acts based on a measurement resulting from said step of measuring performance, wherein the one or more acts includes sending data indicating the measurement to an entity over the network; and
sending the modified item over the network to the client process executing on the client device.”

It is respectfully submitted that Claim 1 is patentable over *Burgess* and *Grimm* because Claim 1 recites one or more limitations that are not taught or suggested by *Burgess* or *Grimm*, considered alone or in combination. For example, it is respectfully submitted that the Claim 1 limitations “intercepting an item generated by an application program executing on a server device that is to be sent over a network to a client process executing on a client device, wherein the intercepting is performed prior to arrival of the item at the client process” and “sending the modified item over the network to the client process executing on the client device” are not taught or suggested by *Burgess* and *Grimm*, considered alone or in combination. The Office Action asserted that these limitations are not taught or suggested by *Burgess* and relied upon

Grimm for these limitations. No further discussion of *Burgess* is therefore provided with respect to these limitations.

Grimm describes an approach for modifying a software component to implement a security policy defined for a site where the software component is executed. When a software component needs to be loaded for execution, i.e., linked and activated, by a computer, an introspection service 13 intercepts the software component for analysis. An interposition service 17 modifies the software component to adhere to the security policies of the computer. This includes adding code to the original software component to generate a modified software component 21. The modified software component 21 is then loaded and made available for execution in place of the original software component. When executed, the modified software component 21 invokes the necessary security services, which maintains the security state of the computer.

As in prior Office Actions, in the present Office Action, the original software component of *Grimm* is considered to be the “item” recited in Claim 1 and the modified software component 21 is considered to be the “modified item” recited in Claim 1. It is respectfully submitted that the aforementioned “intercepting” limitation is not taught or suggested by *Grimm* because *Grimm* does not teach or suggest that the original software component is ever sent over a network to a client device. *Grimm* describes only that the original software component is loaded for execution on a single computer. Thus, it is respectfully submitted that the “intercepting an item generated by an application program executing on a server device *that is to be sent over a network to a client process executing on a client device* wherein the intercepting is performed prior to arrival of the item at the client process” (emphasis added) is not taught or suggested by *Grimm*. Furthermore, it is respectfully submitted that the “sending” limitation recited in Claim 1

is not taught or suggested by *Grimm* because *Grimm* does not teach or suggest that the modified software component 21 is ever sent over a network to a client device. Rather, the modified software component 21 is loaded and executed on the same computer as the original software component. It is therefore respectfully submitted that the Claim 1 limitation “sending the modified item over the network to the client process executing on the client device” is also not taught or suggested by *Grimm*.

As another example, it is also respectfully submitted that *Burgess* and *Grimm* do not teach or suggest the Claim 1 limitations:

“modifying the item transparently with respect to the application program to produce a modified item that includes code which, when processed by one or more processors at the client device causes:
at the client device, measuring performance related to a service associated with the item, and
at the client device, performing one or more acts based on a measurement resulting from said step of measuring performance, wherein the one or more acts includes sending data indicating the measurement to an entity over the network;”

As recited in Claim 1, the measuring of the performance and performing the one or more acts at the client device are performed in response to the code included in the modified item that was received over the network from the server device being processed by one or more processors at the client device. In the Office Action, *Burgess* was relied upon for teaching the aforementioned limitations of Claim 1. In *Burgess*, the measuring of the performance is performed by monitoring and tracking agent 16. *Burgess* describes that monitoring and tracking agent 16 is normally run as an operating system service on monitored computer 12. Thus, the measuring performed in *Burgess* is performed in response to the initiation of an operating system service that is resident on monitored computer 12. There is no teaching or suggestion in *Burgess* that the monitoring performed by monitoring and tracking agent 16 is performed in response to

the processing of code received by monitored computer 12 over a network from a server device. It is therefore respectfully submitted that the aforementioned Claim 1 limitations “modifying the item transparently....measurement to an entity over the network” are also not taught or suggested by *Burgess* and *Grimm*.

In view of the foregoing, it is respectfully submitted that Claim 1, as amended, recites one or more limitations that are not taught or suggested by *Burgess* and *Grimm*, considered alone or in combination, and that Claim 1 is therefore patentable over *Burgess* and *Grimm*.

CLAIMS 3, 5, 7, 8-20 AND 29

Claims 3, 5, 7, 8-20 and 29 all depend from Claim 1 and include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 3, 5, 7, 8-20 and 29 are patentable over *Burgess* and *Grimm* for at least the reasons set forth herein with respect to Claim 1. Furthermore, it is respectfully submitted that Claims 3, 5, 7, 8-20 and 29 recite additional limitations that independently render them patentable over *Burgess* and *Grimm*.

For example, Claim 7 recites “the step of modifying the item includes adding code to the item which, when processed by the one or more processors at the client device, causes the client process to issue a request to the server device over the network; and said step of sending data indicating the measurement to an entity further comprises sending the request including the data indicating the measurement to the server device over the network.” *Grimm* does not teach or suggest that executing the modified software component causes a client process at another computer to issue a request to a server device over a network. Similarly, *Burgess* does not teach or suggest that when monitoring and tracking agent 16 is initiated, that it causes a client process on another computer to issue a request to a server device over a network. It is therefore

respectfully submitted that the additional limitations recited in Claim 7 are not taught or suggested by *Grimm* or *Burgess*.

CLAIMS 42, 44, 46, 48-61, 70 AND 83

Claims 42, 44, 46, 48-61 and 70 are similar to Claims 1, 3, 5, 7, 8-20 and 29, except in the context of computer-readable media and Claim 83 is similar to Claim 1. It is therefore respectfully submitted that Claims 42, 44, 46, 48-61, 70 and 83 are patentable over *Burgess* and *Grimm* for at least the reasons set forth herein with respect to Claims 1, 3, 5, 7, 8-20 and 29.

In view of the foregoing, it is respectfully submitted that Claims 1, 3, 5, 7, 8-20, 29, 42, 44, 46, 48-61, 70 and 83, as amended, are patentable over *Burgess* and *Grimm* and reconsideration and withdrawal of the rejection of Claims 1, 3, 5, 7, 8-20, 29, 42, 44, 46, 48-61, 70 and 83 under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* is respectfully requested.

REJECTION OF CLAIMS 6 AND 47 UNDER 35 U.S.C. § 103(a)

In the Office Action, Claims 6 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Dustan et al.*, U.S. Patent No. 5,884,312 (hereinafter "*Dustan*"). It is respectfully submitted that Claims 6 and 47 are patentable over *Burgess*, *Grimm* and *Dustan*, considered alone or in combination, for at least the reasons provided hereinafter.

Claim 6 depends from Claim 1 and includes all of the limitations of Claim 1. Claim 47 recites limitations similar to Claim 6, except in the context of a computer-readable medium. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Dustan* and it is understood that *Dustan* was relied upon in the Office

Action for the limitations of Claim 6 and not for the limitations of Claim 1. *Dustan* describes an approach for securely accessing information from disparate data sources through a network.

There is no description or suggestion in *Dustan*, however, of “intercepting an item generated by an application program executing on a server device that is to be sent over a network to a client process executing on a client device, wherein the intercepting is performed prior to arrival of the item at the client process” and “sending the modified item over the network to the client process executing on the client device,” as recited in Claim 1. It is therefore respectfully submitted that Claims 6 and 47 are not taught or suggested by *Burgess*, *Grimm* and *Dustan*, considered alone or in combination, and that Claims 6 and 47 are therefore patentable over *Burgess*, *Grimm* and *Dustan*. Accordingly, reconsideration and withdrawal of the rejection of Claims 6 and 47 under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and in further view of *Dustan* is respectfully requested.

REJECTION OF CLAIMS 21-23 AND 62-64 UNDER 35 U.S.C. § 103(a)

In the Office Action, Claims 21-23 and 62-64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Mattis et al.*, U.S. Patent No. 6,209,003 (hereinafter “*Mattis*”). It is respectfully submitted that Claims 21-23 and 62-64 are patentable over *Burgess*, *Grimm* and *Mattis*, considered alone or in combination, for at least the reasons provided hereinafter.

Claims 24-27 depend from Claim 1 and include all of the limitations of Claim 1. Claims 65-68 recite limitations similar to Claims 24-27, except in the context of computer-readable media. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Mattis* and it is understood that *Mattis* was relied

upon in the Office Action for the limitations of Claims 24-27 and not for the limitations of Claim 1. There is no description or suggestion in *Mattis*, however, of “intercepting an item generated by an application program executing on a server device that is to be sent over a network to a client process executing on a client device, wherein the intercepting is performed prior to arrival of the item at the client process” and “sending the modified item over the network to the client process executing on the client device,” as recited in Claim 1. It is therefore respectfully submitted that Claims 21-23 and 62-64 are not taught or suggested by *Burgess*, *Grimm* and *Mattis*, considered alone or in combination, and that Claims 21-23 and 62-64 are therefore patentable over *Burgess*, *Grimm* and *Mattis*. Accordingly, reconsideration and withdrawal of the rejection of Claims 21-23 and 62-64 under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and in further view of *Mattis* is respectfully requested.

REJECTION OF CLAIMS 24-27 AND 65-68 UNDER 35 U.S.C. § 103(a)

In the Office Action, Claims 24-27 and 65-68 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Simonoff et al.*, U.S. Patent No. 5,944,784 (hereinafter “*Simonoff*”). It is respectfully submitted that Claims 24-27 and 65-68 are patentable over *Burgess*, *Grimm* and *Simonoff*, considered alone or in combination, for at least the reasons provided hereinafter.

Claims 24-27 depend from Claim 1 and include all of the limitations of Claim 1. Claims 65-68 recite limitations similar to Claims 24-27, except in the context of computer-readable media. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Simonoff* and it is understood that *Simonoff* was relied upon in the Office Action for the limitations of Claims 24-27 and not for the limitations of

Claim 1. *Simonoff* describes operating methods for a universal client device. There is no description or suggestion in *Simonoff*, however, of “intercepting an item generated by an application program executing on a server device that is to be sent over a network to a client process executing on a client device, wherein the intercepting is performed prior to arrival of the item at the client process” and “sending the modified item over the network to the client process executing on the client device,” as recited in Claim 1. It is therefore respectfully submitted that Claims 24-27 and 65-68 are not taught or suggested by *Burgess*, *Grimm* and *Simonoff*, considered alone or in combination, and that Claims 24-27 and 65-68 are therefore patentable over *Burgess*, *Grimm* and *Simonoff*. Accordingly, reconsideration and withdrawal of the rejection of Claims 24-27 and 65-68 under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and in further view of *Simonoff* is respectfully requested.

REJECTION OF CLAIMS 28, 30, 69 AND 71 UNDER 35 U.S.C. § 103(a)

In the Office Action, Claims 28, 30, 69 and 71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Hoskins et al.*, U.S. Patent No. 6,108,662 (hereinafter “*Hoskins*”). It is respectfully submitted that Claims 28, 30, 69 and 71 are patentable over *Burgess*, *Grimm* and *Hoskins*, considered alone or in combination, for at least the reasons provided hereinafter.

Claims 28 and 30 depend from Claim 1 and include all of the limitations of Claim 1. Claims 69 and 71 recite limitations similar to Claims 28 and 30, except in the context of computer-readable media. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Hoskins* and it is understood that *Hoskins* was relied upon in the Office Action for the limitations of Claims 28 and 30 and not

for the limitations of Claim 1. *Hoskins* describes a system software solution for controlling an enterprise. There is no description or suggestion in *Hoskins*, however, of “intercepting an item generated by an application program executing on a server device that is to be sent over a network to a client process executing on a client device, wherein the intercepting is performed prior to arrival of the item at the client process” and “sending the modified item over the network to the client process executing on the client device,” as recited in Claim 1. It is therefore respectfully submitted that Claims 28, 30, 69 and 71 are not taught or suggested by *Burgess*, *Grimm* and *Hoskins*, considered alone or in combination, and that Claims 28, 30, 69 and 71 are therefore patentable over *Burgess*, *Grimm* and *Hoskins*. Accordingly, reconsideration and withdrawal of the rejection of Claims 28, 30, 69 and 71 under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and in further view of *Hoskins* is respectfully requested.

REJECTION OF CLAIMS 31, 32, 72 AND 73 UNDER 35 U.S.C. § 103(a)

In the Office Action, Claims 31, 32, 72 and 73 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Nasu et al.*, U.S. Patent No. 5,671,402 (hereinafter “*Nasu*”). It is respectfully submitted that Claims 31, 32, 72 and 73 are patentable over *Burgess*, *Grimm* and *Nasu*, considered alone or in combination, for at least the reasons provided hereinafter.

Claims 31 and 32 depend from Claim 1 and include all of the limitations of Claim 1. Claims 72 and 73 recite limitations similar to Claims 31 and 32, except in the context of computer-readable media. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Nasu* and it is understood that

Nasu was relied upon in the Office Action for the limitations of Claims 31 and 32 and not for the limitations of Claim 1. *Nasu* describes a method for evaluating a data processing rate using simulation. There is no description or suggestion in *Nasu*, however, of “intercepting an item generated by an application program executing on a server device that is to be sent over a network to a client process executing on a client device, wherein the intercepting is performed prior to arrival of the item at the client process” and “sending the modified item over the network to the client process executing on the client device,” as recited in Claim 1. It is therefore respectfully submitted that Claims 31, 32, 72 and 73 are not taught or suggested by *Burgess*, *Grimm* and *Nasu*, considered alone or in combination, and that Claims 31, 32, 72 and 73 are therefore patentable over *Burgess*, *Grimm* and *Nasu*. Accordingly, reconsideration and withdrawal of the rejection of Claims 31, 32, 72 and 73 under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and in further view of *Nasu* is respectfully requested.

REJECTION OF CLAIMS 33-41, 74-82 AND 84 UNDER 35 U.S.C. § 103(a)

In the Office Action, Claims 33-41, 74-82 and 84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Raz et al.*, U.S. Pub. No. 2001/0037400 A1 (hereinafter “*Raz*”). It is respectfully submitted that Claims 33-41, 74-82 and 84 are patentable over *Burgess*, *Grimm* and *Raz*, considered alone or in combination, for at least the reasons provided hereinafter.

Claims 33-41 depend from Claim 1 and include all of the limitations of Claim 1. Claims 74-82 and 84 recite limitations similar to Claims 33-41, except in the context of computer-readable media. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these

limitations are also not taught or suggested by *Raz* and it is understood that *Raz* was relied upon in the Office Action for the limitations of Claims 33-41 and not for the limitations of Claim 1. *Raz* describes a method for decreasing the user-perceived system response time in Web-based systems. There is no description or suggestion in *Raz*, however, of “intercepting an item generated by an application program executing on a server device that is to be sent over a network to a client process executing on a client device, wherein the intercepting is performed prior to arrival of the item at the client process” and “sending the modified item over the network to the client process executing on the client device,” as recited in Claim 1. It is therefore respectfully submitted that Claims 33-41, 74-82 and 84 are not taught or suggested by *Burgess*, *Grimm* and *Raz*, considered alone or in combination, and that Claims 33-41, 74-82 and 84 are therefore patentable over *Burgess*, *Grimm* and *Raz*. Accordingly, reconsideration and withdrawal of the rejection of Claims 33-41, 74-82 and 84 under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and in further view of *Raz* is respectfully requested.

CONCLUSION

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

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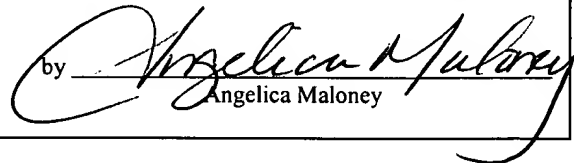
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on January 6, 2006

by


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